

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|-------------------------------|------------------|
| 09/845,708 | 04/30/2001 | James R.H. Challenger | YOR9-2001-0281US1 (8728-5) | 2686 |

7590 07/16/2004

Frank Chau
F. CHAU & ASSOCIATES, LLP
Suite 501
1900 Hempstead Turnpike
East Meadow, NY 11554

EXAMINER

PAULA, CESAR B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2178

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,708

Applicant(s)

CHALLENGER ET AL.

Examiner

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4/30/01. 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the application filed on 4/30/2001.

This action is made Non-Final.

2. Claims 1-31 are pending in the case. Claims 1, 13, 16, and 28 are independent claims.

Information Disclosure Statement

3. The information disclosure statement filed 9/22/2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent (Canadian Patent); each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

4. The drawings filed on 4/30/2001 have been approved by the examiner.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

Art Unit: 2178

the invention. It is unclear, and confusing from claim 25 as to which component (client or host) is making the determinations (lines 3-6), requesting (line 7), receiving, obtaining, verifying, etc., (lines 9-15).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-8, 13-15, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky et al, hereinafter Troyansky (US Pub.# 2003/0190054 A1, 10/9/2003, Provisional application filed on 10/3/2000), in view of Lemay et al, "Laura Lemay's Web Workshop Creating Commercial Web Pages", hereinafter Lemay, Sams.net, 1996, pp.110-115)

Regarding independent claim 1, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), are obtained, and then watermarked by converting those HTML parts into an image--*media file*.

Art Unit: 2178

Moreover, Troyansky teaches inserting—*storing*-- a digital watermark into digital content by replacing parts of digital files, such as HTML files with hidden images--*watermarks*--such as image (0003). In other words the parts of the HTML files are watermarked by converting those HTML parts into an image--*media file*. Troyansky fails to explicitly disclose: *providing a tag within the HTML document referencing the stored media file*. However, Lemay teaches inserting an image into a web page, such as an album cover, using an "" tag, which references an image of the album cover (page 111, lines 21-32, page 112, lines 15-22, and fig. 6.5). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, and Lemay and place the image or media file into an HTML page using an "" tag, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the HTML document from unauthorized use.

Regarding claim 3, which depends on claim 1, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files with hidden images--*watermarks*--such as image (0003). In other words the parts of the HTML files are watermarked by converting those HTML parts into an image.

Regarding claim 4, which depends on claim 1, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *an expression of an idea within the textual content is the property of an entity*. However, Lemay teaches inserting an image into a web page, such as an

Art Unit: 2178

album title—"ABBA: You Can Dance, You Can Cry"--, using an "<H1>" tag -- HTML entity (page 112, line 22, and fig. 6.5). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, and Lemay and place the album title into an HTML page using an "<H1>" tag, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the HTML document from unauthorized use.

Regarding claim 5, which depends on claim 3, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files with hidden images--*watermarks*--such as image (0003). In other words the parts of the HTML files are watermarked by converting those HTML parts into an image.

Regarding claim 6, which depends on claim 5, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files with hidden images--*watermarks*--such as image. The watermarks are used to enforce rights to digital media to be distributed to an authorized party (0002-0003). In other words the parts of the HTML files are watermarked by converting those HTML parts into an image--*media file*.

Regarding claim 7, which depends on claim 1, Troyansky teaches compressing a watermark using lossy compression algorithms--*compression preference* (0004, lines 6-9).

Regarding claim 8, which depends on claim 1, Troyansky teaches compressing a watermark using lossy compression algorithms--*file format* (0004, lines 6-9).

Art Unit: 2178

Regarding independent claim 13, Troyansky teaches inserting a digital watermark into digital content --*determining a content creation preference*--by replacing or converting parts of digital files, such as HTML files--*electronically encoded document*-- with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by converting those HTML parts, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), into an image--*media file*.

Moreover, Troyansky fails to explicitly disclose: *obtaining the electronically encoded document*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to obtain the HTML file, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Furthermore, Troyansky teaches distributing digital content, such as the watermarked HTML files, to an authorized user--*content in image format to client* (0003).

Regarding claim 14, which depends on claim 13, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files with hidden images--*watermarks*--such as image (0003). In other words the parts of the HTML files are watermarked by converting those HTML parts into an image.

Claim 15 is directed towards a method for implementing the steps found in claim 7, and therefore is similarly rejected.

Art Unit: 2178

Claims 28-30 are directed towards program instructions stored on a program storage device for executing the steps found in claims 1, 3, and 5 respectively, and therefore are similarly rejected.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Lemay, and further in view of "Using Netscape, The User-Friendly Reference", Ernst, W., hereinafter Netscape, QUE, 1995, pp.324-327.

Regarding claim 9, which depends on claim 1, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *the media file is stored in one of a client-side database and a networked cache*. However, Netscape teaches the temporarily storing previously viewed web pages, in a browser's computer (page 325, lines 17-page326, line 14). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Lemay, and Netscape, because Netscape teaches above storing previously viewed web pages locally in the computer's temporary directory or cache. Thus, providing the benefit of quickly accessing the web pages, which also contain images.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Lemay, and further in view of Davis et al, hereinafter Davis (US PUB.# 20040037449, 2/26/2004, Provisional filed on 2/4/2000).

Art Unit: 2178

Regarding claim 2, which depends on claim 1, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as image files with hidden images--*watermarks* (0003). Troyansky fails to explicitly disclose: *the media file is sound file*. However, Davis teaches embedding audio, such as synthesized text, watermarks into media signals (0041). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Lemay, and Davis, because Troyansky teaches enforcing digital rights of image documents, by inserting watermarked information into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use using hidden audio files.

11. Claims 10-12, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Lemay, and further in view of "Adobe PageMill 2.0 Handbook", Lewis, R., hereinafter Pagemill, Hayden Books, 1996, pp.138-143.

Regarding claim 10, which depends on claim 3, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *generating an image map corresponding to the image file, according to a mapping preference*. However, Pagemill teaches inserting an active image, which contains more than one URL, using a "USEMAP" attribute—*mapping preference*--, into a web page (page 139, page 141, lines 24-34, and fig. 6.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Lemay, and Pagemill, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting

Art Unit: 2178

watermarked image files into the document (002-003). Thus, providing the benefit of protecting data in the HTML document from unauthorized use.

Regarding claim 11, which depends on claim 3, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *the mapping preference relates selectable spatial display coordinates to external document identifiers in order to enable user navigation*. However, Pagemill teaches inserting an active image, which contains more than one URL. The image is divided into areas, setup by coordinates along with their associated URLs. When a user clicks on an area, the browser jumps to the URL—*external document identifier*-- of the respective area (page 139, lines 21-33, and fig. 6.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Lemay, and Pagemill, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting data in the HTML document from unauthorized use.

Regarding claim 12, which depends on claim 3, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *converting the textual content to a media file eliminates the use of scripting commands for presenting the textual content*. However, Pagemill teaches inserting an active image, which contains more than one URL. The image is divided into areas, setup by coordinates along with their associated URLs (page 139, lines 21-33, and fig. 6.1). This means, that the necessity of the need for using scripting commands to present textual content,

Art Unit: 2178

since images are being used. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Lemay, and Pagemill, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting data in the HTML document from unauthorized use.

Claim 31 is directed towards program instructions stored on a program storage device for executing the steps found in claim 10, and therefore is similarly rejected.

12. Claims 16-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Lemay, and further in view of Truong (Pat.# 6,151,609, 11/21/2000).

Regarding independent claim 16, Troyansky teaches inserting a digital watermark into digital content—*determining a content creation preference*--by replacing or converting parts of digital files, such as HTML files—*electronically encoded HTML document*-- with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), into an image.

Furthermore, Troyansky fails to explicitly disclose: *receiving a request for the content from a client; obtaining the content in text format*. However, Truong teaches an Internet server receiving an HTML file selection. In response, the Internet server communicates the HTML file in textual format to a requesting client (col.8, lines 38-53). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky,

Art Unit: 2178

Lemay, and Truong, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 17, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-36), with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts into an image.

Regarding claim 18, which depends on claim 13, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as image files with hidden images--*watermarks* (0003). Troyansky fails to explicitly disclose: *receiving a request for the content from a client; obtaining the content in text format*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have retrieved the image file, because Troyansky teaches enforcing digital rights of image documents, by inserting watermarked information into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 19, which depends on claim 16, Troyansky teaches compressing a watermark using lossy compression algorithms--*watermarking preference* (0004, lines 6-9).

Regarding claim 20, which depends on claim 19, Troyansky teaches compressing a watermark using lossy compression algorithms--*compression preference* (0004, lines 6-9).

Regarding claim 22, which depends on claim 16, Troyansky teaches inserting or storing a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files with hidden images--*watermarks*--such as image (0003).

Regarding claim 23, which depends on claim 22, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as image files with hidden images--*watermarks* (0003). Troyansky fails to explicitly disclose: *an HTML containing a reference to the stored content in the image format for retrieval and inline dynamic assembly by the client*. However, Truong teaches the using a web browser for interpreting HTML tags and displaying images identify by the tags--*dynamically assembling by the client browser of identified images*—(col.6, lines 55-67, col.7, lines 7-40). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have retrieved the image file, because Troyansky teaches enforcing digital rights of image documents, by inserting watermarked information into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

13. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Lemay, and further in view of Truong, and further in view of Pagemill.

Art Unit: 2178

Regarding claim 21, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *the mapping preference relates selectable spatial display coordinates to external document identifiers in order to enable user navigation*. However, Pagemill teaches inserting an active image, which contains more than one URL. The image is divided into areas, setup by coordinates along with their associated URLs. When a user clicks on an area, the browser jumps to the URL—*external document identifier*-- of the respective area (page 139, lines 21-33, and fig. 6.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Lemay, Truong, and Pagemill, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting data in the HTML document from unauthorized use.

14. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Lemay, and further in view of Truong, and further in view of Minematsu (Pat.# 6,700,993, 3/2/2004, filed on 9/6/2000).

Regarding claim 24, which depends on claim 19, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files such as image (0003). Troyansky fails to explicitly disclose: *receiving a client system request for verification of the watermarked content*. However, Minematsu teaches a user terminal transmitting first transmission of watermarked information to a detection center, where

Art Unit: 2178

the information is authenticated. The information is then transmitted to the user terminal, where the authentication result is displayed (col.3, lines 61-col.4, line 67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Lemay, and Minematsu, because Minematsu teaches providing a tamper resistant watermarked image for encrypting information (col. 3, lines 57-67). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rhoads (Pat. # 6,427,020), Van Wie et al. (Pat. # 6,618,484), and Olsson et al. (Pat. # 6,333,031).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is **(703) 306-5543**. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Application/Control Number: 09/845,708

Page 15

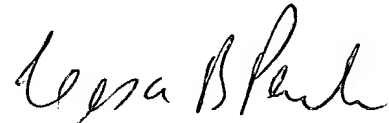
Art Unit: 2178

Alexandria, VA 22313-1450

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).**



CESAR B PAULA
Patent Examiner
Art Unit 2178

7/15/04